

In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

### **REMARKS/ARGUMENTS**

Claims 1-4, 43-46, and 90-103 are currently pending in the present application. Claims 1-4, 43-46, and 90-103 stand rejected. No claims have been amended, added or cancelled. Reconsideration of the pending claims is requested in light of the present amendments and remarks.

As an initial matter, Applicant respectfully requests that the finality of this Office Action be withdrawn. Under present practice, a second or any subsequent action on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicants' amendment of the claims not based on information submitted in an information disclosure statement. MPEP 706.07(a). Applicants' respectfully submit that that the Examiner's new grounds for rejection was not necessitated by Applicants' amendment of that claims.

In its Response to the Office Action dated February 9, 2007 (submitted on May 23, 2007), the claims were amended by changing the term "third" server to "second" server. This was done because there was no specific reference to "a second" server in the claims and Applicant believed the amendment would alleviate any potential confusion that might arise. The amendment was not made for the purposes of patentability and did not change the scope of the claims. Therefore, Applicants' respectfully submit that the new grounds of rejection was not necessitated by the amendment and request that the finality of this Office Action be withdrawn.

#### **Rejections of Claims 1, 2, 43, 44 and 90 under 35 U.S.C. 102(e)**

The Examiner has rejected claims 1, 2, 43, 44 and 90 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,171,662 to Misra et al. ("Misra"). Applicants respectfully traverse the rejection.

Applicants respectfully submit that Misra does not disclose, teach, or suggest all the elements of claim 1. Claim 1 is directed to a method for conducting a transaction. Among other

In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

steps, claim 1 requires (a) receiving, at a first server, a transaction request from a user for a transaction at a merchant server, (b) issuing a challenge to a second server and forwarding the challenge from said second server to the user, wherein said challenge is passed to an intelligent token for processing said challenge, wherein said intelligent token generates a response to said challenge, and (d) processing said response at said second server to verify the intelligent token.

Misra is directed to system and method for licensing software and in particular, a system and method for enforcing software licenses. Misra teaches a license server 28 (first server) that initiates a client challenge by generating a challenge and sending it to the intermediate server 32 (second server). The intermediate server 28 (second server) then forwards the challenge to the client (*i.e.*, user). The client (*i.e.*, user) then responds to challenge by sending the response, which contains trusted information about the client, to the intermediate server 32 (second server), which forwards the response to the license server 28 (first server). Based on the response, the license server (first server) determines whether the client (*i.e.*, user) is authentic. (See Misra, col. 15, lns. 13-33).

However, Misra fails to teach receiving, at a first server, a transaction request from a user for a transaction at a merchant server. Instead, Misra is directed to a method for software licensing and not a method for conducting a transaction. Misra teaches that when a client 30 (*i.e.*, user) connects to the intermediate server 32 (second server), the client 30 (*i.e.*, user) must present a valid license. If the client 30 (*i.e.*, user) does not have a valid license, the intermediate server 32 (second server) assists the client 30 (*i.e.*, user) in obtaining a license from the license server 28 (first server). (Misra, col. 4, lns. 60-63). In the event that a license must be obtained, the license server 28 (first server) receives a request for a license to use software on the intermediate server 32 (second server). The license server 28 (first server) never receives a request from a user for a transaction on a

In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

merchant server. Indeed, Misra does not disclose, teach, or suggest the concept of a merchant server, as required by claim 1.

In addition, Misra fails to teach “issuing a challenge to a second server and forwarding the challenge from said second server to the user, *wherein said challenge is passed to an intelligent token for processing said challenge, wherein said intelligent token generates a response to said challenge.*” Instead, in Misra, the client (*i.e.*, user) generates a response to the client without the use of an intelligent token. (See Misra, col. 15, lns. 24-25). The use of an intelligent token provides additional security that is not found in the system and method disclosed in Misra. In fact, Misra fails to disclose, teach, or suggest the concept of using an intelligent token to provide additional security protections. As explained in the specification of the present application, in one example, a separate smart card (*e.g.*, intelligent token) 202, can interact with the customer (*i.e.*, user) to prompt the user for a personal identifier to access the smart card. (See Application, p. 23, lns. 24-33). This added security, which is not disclosed, taught, or suggested by Misra, provides the claimed invention with added confidence in the identity of the user, thereby justifying a lower discount rate for the transaction service. (See Application, p. 26, lns. 9-12).

Misra also fails to teach the step of “processing said response at said second server to verify the intelligent token”. Instead Misra teaches that the response to the challenge is verified at the license server 28 (first server). The intermediate server 32 (second server) receives the response from client (*i.e.*, user) but *does not verify* whether the response is authentic. Rather, the intermediate server 32 (second server) simply forwards the response from the client (*i.e.*, user) to the license server 28 (first server). (See Misra, col. 15, lns. 22-23) The license server 28 (first server) – not the intermediate server 32 (second server) – determines whether the response is

In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

authentic. Conversely, in the claimed invention, a wallet server (second server) processes the response from the user to verify whether the response is authentic.

Indeed, Applicants further submit that there is no suggestion to modify Misra to include the elements identified above. The system and method disclosed in Misra is intended to assure that the terms of a software license are being met and assist the licensee in monitoring whether is it in compliance with the software license. (Misra, col. 2, lns. 12-16). Conversely, the claimed invention is intended to provide additional security during a transaction between a merchant and a user.

Consequently, Misra fails to disclose, teach, or suggest all the elements of claim 1. Therefore, Applicants' respectfully submit that claim 1 is patentable over Misra. Additionally, claim 2 depends on claim 1, and include all of its elements. Therefore, Applicants respectfully submit claim 2 is also patentable over Misra.

Similarly, Applicants respectfully submit that Misra does not disclose, teach, or suggest the elements of claim 43. Claim 43 is directed to a method of conducting a transaction. Among other elements, claim 43 requires (a) receiving, at a first server, a transaction request from a user for a transaction at a merchant server, (b) issuing a challenge to a second server and forwarding the challenge from said second server to the user, wherein said challenge is passed to an intelligent token for processing said challenge, wherein said intelligent token generates a response to said challenge, and (d) processing said response at said second server to verify the user.

As stated with respect to claim 1, Misra fails to teach receiving, at a first server, a transaction request from a user for a transaction at a merchant server. Instead, Misra teaches that when a client 30 (*i.e.*, user) connects to the intermediate server 32 (second server), the client must present a valid license. If the client 30 (*i.e.*, user) does not have a valid license, the intermediate

In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

server 32 (second server) assists the client 30 (*i.e.*, user) in obtaining a license from the license server 28 (first server). (Misra, col. 4, lns. 60-63). In the event that a license must be obtained, the license server 28 (first server) receives a request for a license to use software on the intermediate server 32 (second server). The license server 28 (first server) never receives a request from a user for a transaction on a merchant server. Indeed, Misra does not disclose, teach, or suggest the concept of a merchant server, as required by claim 43.

In addition, as stated with respect to claim 1, Misra fails to teach "issuing a challenge to a second server and forwarding the challenge from said second server to the user, *wherein said challenge is passed to an intelligent token for processing said challenge, wherein said intelligent token generates a response to said challenge.*" Instead, in Misra, the client (*i.e.*, user) generates a response to the client without the use of an intelligent token. (See Misra, col. 15, lns. 24-25). The use of an intelligent token provides additional security that is not found in the system and method disclosed in Misra. In fact, Misra fails to disclose, teach, or suggest the concept of using an intelligent token to provide additional security protections. As explained in the specification of the present application, in one example, a separate smart card (*e.g.*, intelligent token) 202, can interact with the customer (*i.e.*, user) to prompt the user for a personal identifier to access the smart card. (See Application, p. 23, lns. 24-33). This added security, which is not disclosed, taught, or suggested by Misra, provides the claimed invention with added confidence in the identity of the user, thereby justifying a lower discount rate for the transaction service. (See Application, p. 26, lns. 9-12).

Further as stated above with respect to claim 1, Misra also fails to teach the step of "processing said response at said second server to verify the intelligent token". Instead Misra teaches that the response to the challenge is verified at the license server 28 (first server). The

In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

intermediate server 32 (second server) receives the response from client (*i.e.*, user) but *does not verify* whether the response is authentic. Rather, the intermediate server 32 (second server) simply forwards the response from the client (*i.e.*, user) to the license server 28 (first server). (See Misra, col. 15, lns. 22-23) The license server 28 (first server) – not the intermediate server 32 (second server) – determines whether the response is authentic. Conversely, in the claimed invention, a wallet server (second server) processes the response from the user to verify whether the response is authentic.

Indeed, Applicants further submit that there is no suggestion to modify Misra to include the elements identified above. The system and method disclosed in Misra is intended to assure that the terms of a software license are being met and assist the licensee in monitoring whether is it in compliance with the software license. (Misra, col. 2, lns. 12-16). Conversely, the claimed invention is intended to provide additional security during a transaction between a merchant and a user.

Consequently, Misra fails to disclose, teach, or suggest all the elements of claim 43. Therefore, Applicants' respectfully submit that claim 43 is patentable over Misra. Additionally, claim 44 depends on claim 43, and include all of its elements. Therefore, Applicants respectfully submit claim 44 is also patentable over Misra.

Similarly, Applicants respectfully submit that Misra does not disclose, teach, or suggest the elements of claim 90. Claim 90 is directed to a method of conducting a transaction. Among other elements, claim 90 requires (a) receiving, at a first server, a transaction request from a user for a transaction at a merchant server, (b) issuing a challenge to a second server and forwarding the challenge from said second server to the user, wherein said challenge is passed to an intelligent

In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

token for processing said challenge, wherein said intelligent token generates a response to said challenge, and (d) processing said response at said second server to verify the user.

As stated with respect to claim 1, Misra fails to teach receiving, at a first server, a transaction request from a user for a transaction at a merchant server. Instead, Misra teaches that when a client 30 (*i.e.*, user) connects to the intermediate server 32 (second server), the client must present a valid license. If the client 30 (*i.e.*, user) does not have a valid license, the intermediate server 32 (second server) assists the client 30 (*i.e.*, user) in obtaining a license from the license server 28 (first server). (Misra, col. 4, lns. 60-63). In the event that a license must be obtained, the license server 28 (first server) receives a request for a license to use software on the intermediate server 32 (second server). The license server 28 (first server) never receives a request from a user for a transaction on a merchant server. Indeed, Misra does not disclose, teach, or suggest the concept of a merchant server, as required by claim 90.

In addition, as stated with respect to claim 1, Misra fails to teach "issuing a challenge to a second server and forwarding the challenge from said second server to the user, *wherein said challenge is passed to an intelligent token for processing said challenge, wherein said intelligent token generates a response to said challenge.*" Instead, in Misra, the client (*i.e.*, user) generates a response to the client without the use of an intelligent token. (See Misra, col. 15, lns. 24-25). The use of an intelligent token provides additional security that is not found in the system and method disclosed in Misra. In fact, Misra fails to disclose, teach, or suggest the concept of using an intelligent token to provide additional security protections. As explained in the specification of the present application, in one example, a separate smart card (*e.g.*, intelligent token) 202, can interact with the customer (*i.e.*, user) to prompt the user for a personal identifier to access the smart card. (See Application, p. 23, lns. 24-33). This added security, which is not disclosed, taught, or

In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

suggested by Misra, provides the claimed invention with added confidence in the identity of the user, thereby justifying a lower discount rate for the transaction service. (See Application, p. 26, lns. 9-12).

Further as stated above with respect to claim 1, Misra also fails to teach the step of "processing said response at said second server to verify the intelligent token". Instead Misra teaches that the response to the challenge is verified at the license server 28 (first server). The intermediate server 32 (second server) receives the response from client (*i.e.*, user) but *does not verify* whether the response is authentic. Rather, the intermediate server 32 (second server) simply forwards the response from the client (*i.e.*, user) to the license server 28 (first server). (See Misra, col. 15, lns. 22-23) The license server 28 (first server) – not the intermediate server 32 (second server) – determines whether the response is authentic. Conversely, in the claimed invention, a wallet server (second server) processes the response from the user to verify whether the response is authentic.

Indeed, Applicants further submit that there is no suggestion to modify Misra to include the elements identified above. The system and method disclosed in Misra is intended to assure that the terms of a software license are being met and assist the licensee in monitoring whether is it in compliance with the software license. (Misra, col. 2, lns. 12-16). Conversely, the claimed invention is intended to provide additional security during a transaction between a merchant and a user.

Applicants respectfully submit that Misra fails to disclose, teach, or suggest all the elements of claim 90 and thus, claim 90 is patentable over Misra.

**Rejections of Claims 3 and 45 under 35 U.S.C. 103(a)**

The Examiner has rejected claims 3 and 45 are rejected under 35 U.S.C. 103(a) as being



In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

unpatentable over Misra and further in view of U.S. Patent No. 6,327,578 to Linehan.

As stated above, Misra fails to disclose, teach, or suggest all the elements of claims 1 and 43 and thus, claims 1 and 43 are patentable over Misra. Claims 3 and 45 depends on claims 1 and 43, respectively, and therefore include all of the elements of its respective independent claims. Therefore, Applicants respectfully submit claims 3 and 45 are also patentable over Misra in view of Linehan.

**Rejections of Claims 4, 46, 91-93, 96-98, and 103 under 35 U.S.C. 103(a)**

The Examiner has rejected claims 4, 46, 91-93, 96-98, and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra as applied to claims 1 and 90 above, and further in view of U.S. Patent No. 6,873,974 to Schutzer.

As stated above, Misra fails to disclose, teach, or suggest all the elements of claims 1, 43, 90 and 98. Therefore, claims 1, 43, and 90 are patentable over Misra. Claim 4 depends on claim 1 and therefore includes all the elements of claim 1. Claim 46 depends on claim 43 and therefore includes all the elements of claim 43. Claims 96-97 depend on claim 90 and therefore includes all the elements of claim 90. Therefore, Applicants respectfully submit claims 4, 46, 91-93, and 96-97 are also patentable over Misra in view of Schutzer.

In addition, the Examiner has rejected claim 98 on the rationale of claims 90 and 91. Applicants also respectfully submit that Misra does not disclose, teach, or suggest the elements of claim 98. Claim 98 is directed to a method of conducting an electronic purchase transaction. Among other elements, claim 98 requires (a) receiving, at a first server, a transaction request from a user for a transaction at a merchant server, (b) issuing a challenge to a second server and forwarding the challenge from said second server to the user, wherein said challenge is passed to an intelligent

In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

token for processing said challenge, wherein said intelligent token generates a response to said challenge, and (d) processing said response at said second server to verify the user.

As stated with respect to claim 90 and 91, Misra fails to teach receiving, at a first server, a transaction request from a user for a transaction at a merchant server. Instead, Misra teaches that when a client 30 (*i.e.*, user) connects to the intermediate server 32 (second server), the client must present a valid license. If the client 30 (*i.e.*, user) does not have a valid license, the intermediate server 32 (second server) assists the client 30 (*i.e.*, user) in obtaining a license from the license server 28 (first server). (Misra, col. 4, lns. 60-63). In the event that a license must be obtained, the license server 28 (first server) receives a request for a license to use software on the intermediate server 32 (second server). The license server 28 (first server) never receives a request from a user for a transaction on a merchant server. Indeed, Misra does not disclose, teach, or suggest the concept of a merchant server, as required by claim 43.

In addition, as stated with respect to claim 90 and 91, Misra fails to teach "issuing a challenge to a second server and forwarding the challenge from said second server to the user, *wherein said challenge is passed to an intelligent token for processing said challenge, wherein said intelligent token generates a response to said challenge.*" Instead, in Misra, the client (*i.e.*, user) generates a response to the client without the use of an intelligent token. (See Misra, col. 15, lns. 24-25). The use of an intelligent token provides additional security that is not found in the system and method disclosed in Misra. In fact, Misra fails to disclose, teach, or suggest the concept of using an intelligent token to provide additional security protections. As explained in the specification of the present application, in one example, a separate smart card (*e.g.*, intelligent token) 202, can interact with the customer (*i.e.*, user) to prompt the user for a personal identifier to access the smart card. (See Application, p. 23, lns. 24-33). This added security, which is not

In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

disclosed, taught, or suggested by Misra, provides the claimed invention with added confidence in the identity of the user, thereby justifying a lower discount rate for the transaction service. (See Application, p. 26, lns. 9-12).

Further as stated above with respect to claim 90 and 91, Misra also fails to teach the step of "processing said response at said second server to verify the intelligent token". Instead Misra teaches that the response to the challenge is verified at the license server 28 (first server). The intermediate server 32 (second server) receives the response from client (*i.e.*, user) but *does not verify* whether the response is authentic. Rather, the intermediate server 32 (second server) simply forwards the response from the client (*i.e.*, user) to the license server 28 (first server). (See Misra, col. 15, lns. 22-23) The license server 28 (first server) – not the intermediate server 32 (second server) – determines whether the response is authentic. Conversely, in the claimed invention, a wallet server (second server) processes the response from the user to verify whether the response is authentic.

Indeed, Applicants further submit that there is no suggestion to modify Misra to include the elements identified above. The system and method disclosed in Misra is intended to assure that the terms of a software license are being met and assist the licensee in monitoring whether is it in compliance with the software license. (Misra, col. 2, lns. 12-16). Conversely, the claimed invention is intended to provide additional security during a transaction between a merchant and a user.

Consequently, Misra fails to disclose, teach, or suggest all the elements of claim 98. Therefore, Applicants' respectfully submit that claim 98 is patentable over Misra in view of Schutzer. Additionally, claim 103 depends on claim 98, and include all of its elements. Therefore, Applicants respectfully submit claim 103 is also patentable over Misra.

In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

**Rejections of Claims 94 and 95 under 35 U.S.C. 103(a)**

The Examiner has rejected claims 94 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra and Schutzer as applied to claim 91 above, and further in view of Linehan.

As stated above, Misra fails to disclose, teach, or suggest all the elements of claim 90. Therefore, claims 90 is patentable over Misra. Claims 94 and 95 depend on claim 91, which depends on claim 90, and therefore include all of the elements of claim 90. Therefore, Applicants respectfully submit claims 94 and 95 are also patentable over Misra and Schutzer in view of Linehan.

**Rejections of Claims 100 and 102 under 35 U.S.C. 103(a)**

The Examiner has rejected claims 100 and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra and Schutzer as applied to claim 98 above, and further in view of Linehan.

As stated above, Misra fails to disclose, teach, or suggest all the elements of claim 98. Therefore, claim 98 is patentable over Misra. Claims 100 and 102 depend on claim 98 and therefore include all of the elements of claim 98. Therefore, Applicants respectfully submit claims 100 and 102 are also patentable over Misra and Schutzer in view of Linehan.

**Rejections of Claim 99 under 35 U.S.C. 103(a)**

The Examiner has rejected claim 99 under 35 U.S.C. 103(a) as being unpatentable over Misra and Schutzer as applied to claim 98 above, and in further in view of U.S. Patent No. 6,263,446 to Kausik et al. ("Kausik").

As stated above, Misra fails to disclose, teach, or suggest all the elements of claim 98. Therefore, claim 98 is patentable over Misra. Claim 99 depends on claim 98 and therefore includes all of the elements of claim 98. Therefore, Applicants respectfully submit claim 99 is also patentable over Misra and Schutzer in view of Kausik.

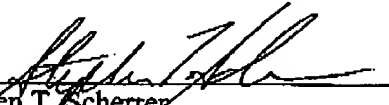
In re Bishop et al.  
U.S. Pat. App. No. 09/652,899

### CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully submit that all of the claims in the Application are in allowable form and that the Application is now in condition for allowance. If, however, any outstanding issues remain, Applicants urge the Examiner to telephone Applicants' attorney so that the same may be resolved and the Application expedited to issue. Applicants respectfully request the Examiner to indicate all claims as allowable and to pass the Application to issue.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

  
Stephen T. Scherrer  
Registration No. 45,080

227 West Monroe Street  
Chicago, IL 60606-5096  
Phone: 312.372.2000  
Facsimile: 312.984.7700  
Date: October 25, 2007

**Please recognize our Customer No. 1923  
as our correspondence address.**

CHI99 4880568-1.037355.0037